REMARKS

Claims 20-35 are currently pending. Previously pending claim 14 is cancelled, and replaced with new claims 20-35. The new claims are supported by the specification throughout, and the limitation regarding promoter size is supported by the instant specification at page 8 line 26 through page 9 line 2. None of the claims constitutes new matter.

The specification is objected to because the status of the parent of the instant application was not updated to reflect its issuance as a patent. This change in status has been noted in an amendment to the specification, such that the objection should be removed.

Claim 14 is rejected under 35 U.S.C. §103(a). For reasons set forth below, the rejection should be removed and the claims should be allowed to issue.

1. The Claims Are Not Obvious

Claim 14 is objected to as obvious under 35 U.S.C. §103(a) over United States Patent No. 5,985,570 by Amutan et al. ("Amutan") in view of Hua-Van et al., 1998, Mol. Gen. Genet. 259:354-362 ("Hua-Van").

The Examiner states that "Amutan teaches a process for using an *Aspergillus niger* (an asexual fungus) transposable element in methods of gene tagging , wherein the transposable element is used to inactivate a gene." The Examiner admits that Amutan does not teach the use of an *Impala* transposon.

The Examiner further states that Hua-Van discloses the *Impala* transposable element, and "teaches that the *Impala* transposon could be a powerful tool for tagging genes in fungi without a sexual cycle because gene isolation in those fungi are very difficult."

The Examiner concludes that it would have been obvious to the skilled artisan to combine the teachings of Amutan and Hua-Van "to utilize the *Impala* transposon as a gene tagging device in fungi" with a reasonable expectation of success.

Applicants respectfully disagree. With regard to the usefulness of *Impala* for gene isolation, Hua-Van states "Hence *impala* might be a powerful tool for tagging genes, at least in *F. oxysporum*, a species in which the absence of sexuality makes gene isolation very difficult. (emphasis added)" This speculative statement indicates that while it might, for the sake of argument, be obvious to try using *impala* for such a purpose, the skilled artisan would not have had the requisite expectation of success. The addition of Amutan, which relates to transposable elements but not *impala*, does not create such an expectation because it relates to other transposable elements, which might or might not share properties with *impala*.

In addition, the new claims contain the limitation that the promoter size is more than 0.4 kb, a limitation which is not taught or rendered obvious by either reference.

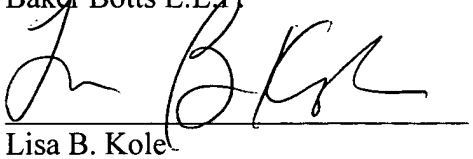
Therefore, neither Amutan nor Hua-Van, nor their combination, would render the new claims obvious. It is therefore requested that the rejection be removed and not applied to the new claims.

2. Conclusion

For all the foregoing reasons, it is believed that the new claims are in condition for allowance.

Addition of the new claims requires the payment of additional claim fees, estimated to be $1160 ((16 x $50 = $800) + $360). Please charge this amount, as well as any other fee deemed necessary, to Deposit Account No. 02-4377. A duplicate of this sheet is attached.

Respectfully submitted,
Baker Botts L.L.P.



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